

REMARKS

Claims 21 – 23, 25, 26 and 28 – 38 are currently pending in the application. By this amendment, claims 25, 30 and 33 have been amended. Applicants submit that no new matter has been added by this amendment. Support for the amendment can be found, for example, at least at page 3, line 30 – page 4, line 5 and page 5, line 27 – page 6, line 7. Reconsideration of the rejected claims in view of the above amendments and following remarks is respectfully requested.

Applicants are not conceding in this application that previously presented claims 25, 30 and 33 are not patentable over the art cited by the Examiner, as the present claim amendment is only for facilitating expeditious prosecution. Applicants respectfully reserve the right to pursue these and other claims in one or more continuations and/or divisional patent applications. Applicants respectfully submit that the application is condition for allowance in view of the above amendments to the claims the following remarks.

Interview Summary

Applicants gratefully acknowledge the courtesy extended to their representative in a telephone interview dated August 21, 2009. In the interview, amendments to claims 25, 30 and 33 were discussed. Additionally, the Examiner suggested claim language that would overcome the applied art. More specifically, the allowable claim features of claim 21 were discussed. By the present amendment, Applicants have amended claims 25, 30 and 33 similar to language used in allowable claim 21.

Allowable Subject Matter

Applicants appreciate the Examiner's indication that claims 21 – 23, 36 and 37 are allowed. By the present amendment, claims 25, 30 and 33 have been amended in a similar manner to allowed claim 21. As such, Applicants respectfully submit that all claims are in condition for allowance.

35 U.S.C. § 103 Rejections

Claims 25, 26, 28, 29 and 38 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,692,213 issued to Goldberg et al. (“Goldberg”) in view of U.S. Patent No. 6,144,376 issued to Connelly (“Connelly”). Claims 30 and 32 – 35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,163,345 issued to Nagouchi et al. (“Nagouchi”) in view of U.S. Patent No. 6,732,369 issued to Schein (“Schein”) and U.S. Patent No. 5,710,601 issued to Marshall et al. (“Marshall”). Claim 31 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Nagouchi in view of Schein, Marshall and U.S. Patent Publication No. 2006/0037044 to Daniels (“Daniels”). These rejections are respectfully traversed.

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness. See MPEP §2142. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference

or to combine reference teachings.¹ Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Applicants submit that the combination of references do not teach or suggest each of the features of the instant invention.

Independent Claim 25 over Goldberg in view of Connelly

Independent claim 25 recites, in pertinent part:

... a display screen for viewing a video program in progress;
at least one summary frame displayed on said display screen at a same time and overlaid with said video program in progress when a programming channel is changed, said at least one summary frame comprising a past frame from said video program in progress; and
a control means for allowing a user to change said video program in progress and for allowing said user to select said at least one summary frame to play at least a segment of said video program in progress corresponding to said selected summary frame,
wherein the at least one summary frame comprises a plurality of said summary frames each corresponding to said video program in progress, and
wherein said summary frames remain on said display screen when said video program is preempted, and
further comprising at least one preview frame comprising a future frame from said video program in progress relative to a real-time broadcast of the video program in progress simultaneously displayed with the at least one summary frame on said display screen overlaid onto said video program in progress.

¹ While the *KSR* court rejected a rigid application of the teaching, suggestion, or motivation ("TSM") test in an obviousness inquiry, the [Supreme] Court acknowledged the importance of identifying "a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does" in an obviousness determination. *Takeda Chemical Industries, Ltd. v. Alphapharm Pty., Ltd.*, 492 F.3d 1350, 1356-1357 (Fed. Cir. 2007) (quoting *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1731 (2007)).
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In addressing previously presented claim 25, the Examiner asserted that Goldberg in view of Connelly teaches or suggests each of the features of the present invention and that it would have been obvious to one of skill in the art to modify Goldberg and combine these references to arrive at instant invention. For the reasons of record, Applicants respectfully disagree.

However, in an effort to further prosecution, Applicants have amended claim 25 to include allowable features of claim 21. Applicants submit that neither Goldberg nor Connelly disclose or teach the features of amended claim 25. For example, Applicants submit that neither Goldberg nor Connelly disclose or teach "at least one preview frame comprising a future frame from said video program in progress relative to a real-time broadcast of the video program in progress simultaneously displayed with the at least one summary frame on said display screen overlaid onto said video program in progress," as recited in claim 25. Moreover, Applicants submit that the Examiner, in stating her reasons for allowance, has expressly acknowledged that the art of record does not teach or suggest "at least one preview frame comprising a future frame from said video program in progress relative to a real-time broadcast of the video program in progress simultaneously displayed with the at least one summary frame on said display screen overlaid onto said video program in progress."

As such, Applicants respectfully submit that Schein in view of Connelly does not teach or suggest each of the features of claim 25, and does not render the present invention unpatentable.

Dependent Claims 26, 28, 29 and 38 over Schein in view of Connelly

Claims 26, 28, 29 and 38 are dependent claims, depending from a distinguishable base claim. Accordingly, these claims should also be in condition for allowance based upon their dependencies.

Accordingly, Applicants respectfully request the rejection over claims 25, 26, 28, 29 and 38 be withdrawn.

Independent Claims 30 and 33 over Nagouchi in view of Schein and Marshall

Claim 30 recites, in pertinent part:

- ... selecting a plurality of summary frames depicting selected events from said video program in progress prior to a broadcast transmission of the video program in progress;
- embedding said summary frames in said video program in progress;
- transmitting said video program in progress comprising said summary frames over a media; and
- displaying said video program in progress in a background and said summary frames in a foreground on a screen of a display device at a same time with said video program in progress when a viewer changes channels to said video program in progress in the background from a video program on another channel in the background,
- further comprising displaying at least one preview frame comprising a future frame from said video program in progress relative to a real-time broadcast of the video program in progress simultaneously with the at least one summary frame on said display screen overlaid onto said video program in progress.

Claim 33 recites, in pertinent part:

- ... selecting a plurality of summary frames depicting selected events from said video program prior to a broadcast transmission of the video program;
- embedding said summary frames in said video program;
- transmitting said video program comprising said summary frames over a media;

simultaneously displaying said video program in progress in a background and said summary frames in a foreground on a screen of a display device when a viewer selects said video program in progress displayed in the background;

writing selected frames from said selecting step only in a row direction of a table; and

reading said selected frames from said table only in a column direction to interleave said summary frames displayed on said screen, further comprising displaying at least one preview frame comprising a future frame from said video program in progress relative to a real-time broadcast of the video program in progress simultaneously with the at least one summary frame on said display screen overlaid onto said video program in progress.

In addressing previously presented claims 30 and 33, the Examiner asserted that Nagouchi in view of Schein and Marshall teaches or suggests each of the features of the present invention and that it would have been obvious to one of skill in the art to modify Nagouchi in view of Schein and Marshall and combine these references to arrive at instant invention.

However, in an effort to further prosecution, Applicants have amended claims 30 and 33 to include allowable features of claim 21. Applicants submit that Nagouchi in view of Schein and Marshall does not teach or suggest the features of amended claims 30 and 33. For example, Applicants submit that Nagouchi in view of Schein and Marshall does not disclose, teach or suggest "displaying at least one preview frame comprising a future frame from said video program in progress relative to a real-time broadcast of the video program in progress simultaneously with the at least one summary frame on said display screen overlaid onto said video program in progress," as recited in claims 30 and 33. Moreover, Applicants submit that the Examiner, in stating her reasons for allowance, has expressly acknowledged that the art of record does not teach or suggest "at least one preview frame comprising a future frame from said video program in progress relative to a real-time broadcast of the video program in progress

simultaneously displayed with the at least one summary frame on said display screen overlaid onto said video program in progress.”

As such, Applicants respectfully submit that Nagouchi in view of Schein and Marshall does not teach or suggest each of the features of claims 30 and 33, and does not render the present invention unpatentable.

Dependent Claims 32, 34 and 35 over Nagouchi in view of Schein and Marshall

Claims 32, 34 and 35 are dependent claims, depending from respective distinguishable base claims. Thus, these claims should also be in condition for allowance based upon their respective dependencies.

Accordingly, for at least these reasons, Applicants respectfully request the rejection of claims 30 and 32 – 35 be withdrawn.

Dependent Claim 31 over Nagouchi in view of Schein, Marshall and Daniels

Claim 31 is a dependent claim, depending from a distinguishable base claim. Thus, this claim should also be in condition for allowance based upon its dependency. Moreover, Applicants submit that Daniels does not cure the above-noted deficiencies of Nagouchi in view of Schein and Marshall. That is, as expressly noted by the Examiner, “the art of record does not teach or suggest ‘at least one preview frame comprising a future frame from said video program in progress relative to a real-time broadcast of the video program in progress simultaneously displayed with the at least one summary frame on said display screen overlaid onto said video program in progress.’”

As such, Applicants submit that Nagouchi in view of Schein, Marshall and Daniels does not teach or suggest each of the features of claim 31, and does not render the present invention unpatentable. Accordingly, Applicants respectfully request the rejection of claim 31 be withdrawn.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants submit that all of the claims are patentably distinct from the applied prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed. Applicants hereby make a written conditional petition for extension of time, if required. Please charge any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 50-0510.

Respectfully submitted,
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